

Serial No. 09/385,834

undue experimentation to practice the claimed invention. As the Examiner has noted, Applicant's claims are directed to a nutritional supplement comprising a sterol ester of an omega three fatty acid. The Examiner's concern is apparently directed to the breadth of the claims when the Application discloses only one example of a synthesis utilizing a sterol. As stated in *In re Marzocchi and Horton*, 169 USPQ 367 (CCPA 1971), "a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirements of the first paragraph of §112, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support." Further, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement."

The Examiner has provided no explanation of why other sterols could not be used to synthesize the claimed invention. It has not been asserted by the Patent Office that the chemical properties of known sterols vary to such an extent that it would not be expected by one of ordinary skill in this art that any such sterol would react as expected by Applicant. As a result, there is no basis to conclude that one skilled in the art would not be able to prepare sterol esters of an omega fatty acid along the general outline of the example in the disclosure.

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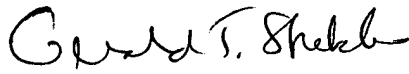
In addition to the above, Applicant encloses a Declaration of Dr. H. Stephen Ewart attesting to the efficacy of the subject invention, i.e., the cholesterol and triglyceride lowering effect in the blood of an animal.

Applicant hereby requests reconsideration and reexamination thereof.

With the above amendments and remarks, this application is considered ready for allowance. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to call the undersigned at the below-listed number.

Respectfully submitted,

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By 

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